

REMARKS/ARGUMENTS

Status of the Claims

Claims 1-7 and 9-11 remain pending in the Application. Claims 8, 12-22 have been cancelled. No new matter has been introduced with these amendments.

Rejections under 35 U.S.C. § 112 should be withdrawn.

Claims 1-7 and 9-11 are rejected under 35 U.S.C. §112 second paragraph, as allegedly being indefinite.

Claim 1 has been rejected as allegedly being indefinite. Applicant respectfully disagrees with the Examiner. Claim 1 is NOT indefinite as the scope of the claim includes different methods for labeling two populations of nucleic acids. Many methods are well known in the art. The specification, for example, page 32; lines 13-20, of the application line discloses also provides examples of the process of labeling the first and second sets of nucleic acids. Withdrawal of this rejection is respectfully requested.

Claim 11 has been rejected as allegedly being indefinite. Applicant respectfully disagrees with the Examiner. The claim language of claim 11 is clear and indicates that the "collection of beads" of claim 3 is not the same as the "collection of bead arrays" of claim 11. Therefore, withdrawal of this rejection is respectfully requested.

Rejections under 35 U.S.C. § 102 should be withdrawn.

Claim 1-7 and 9-11 are rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Fodor et al (USP 5,800,992). Claims 1, 2, 4-7, 9 and 10 are rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Fodor et al (USP 6,309,822). Claims

1-7 and 9-11 are rejected under 35 U.S.C. §102(e) as allegedly being anticipated by Fodor et al (USP 6,576,424). Claims 1, 2, 4-7, 9 and 10 are rejected under 35 U.S.C. §102(e) as allegedly being anticipated by Fodor et al (USP 6,551,784). Applicant respectfully disagrees with the Examiner.

The present claims recite a method for analyzing a nucleic acid sample comprising selecting a first and second sets of nucleic acids from the nucleic acid sample with a first and a second nucleic acid affinity matrices, wherein the first and second nucleic acid affinity matrices hybridizes with two different set of nucleic acids; labeling the first and second sets of nucleic acids based upon the different labels.

In the arguments presented by the Examiner for rejecting the present claims, the Examiner states that the references *read on* the claimed invention which the applicant accepts. However, for a reference to anticipate the claims, the claims should read on the prior art rather than the reverse. The Examiner has not pointed out that each and every element of the claims is disclosed by the cited references. For example, the Examiner fails to point to paragraph 256 of USPN 5,800,992 as disclosing two sets of affinity matrices, but the applicant's representative could not find such disclosure in the cited section. Therefore, withdrawal of these rejections is respectfully requested.

Rejections under 35 U.S.C. § 103 should be withdrawn.

Claims 1-7 and 9-11 are rejected under 103(a) as allegedly being unpatentable over Lichtenwalter (USP 5,683,875) in view of Fodor et al (USP 5,800, 992).

Applicant respectfully disagrees with the Examiner. Applicant hereby submits that the present application is non-obvious since the Examiner has not pointed out where in the references it is discussed the selecting of a first and a second sets of nucleic acids

from the nucleic acid sample with a first and second *nucleic acid affinity matrices* with two different sets of nucleic acids. The Examiner indicates that Lichtenwalter does not teach two different sets of nucleic acid samples or two different sets of nucleic acid affinity matrices and indicates that paragraph 256 of Fodor et al teaches it. However, the applicant's representative does not see where in the references it is discussed the nucleic acid affinity matrices. Since the reference in combination does not teach or suggest the claimed invention, Applicant respectfully submits that the Examiner has failed to establish a prima facie case and therefore requests withdrawal of this rejection.

Double Patenting

Claims 1-7 and 9-11 are rejected on the ground of non statutory obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 5,800,992.

Claims 1, 2 and 4-7 are rejected on the ground of non statutory obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 6,309,822.

Claims 1-7 and 9-11 are rejected on the ground of non statutory obviousness-type double patenting as being unpatentable over claims 16, 17 and 39-64 of U.S. Patent No. 6,576,424.

Claims 1, 2, and 4-7 are rejected on the ground of non statutory obviousness-type double patenting as being unpatentable over claims 1-11 and 20 of U.S. Patent No. 6,551,784.

A terminal disclaimer will be filed upon allowance of the present application.

CONCLUSION

For these reasons, Applicants believe all pending claims are now in condition for allowance. If the Examiner has any questions pertaining to this application or feels that a

telephone conference would in any way expedite the prosecution of the application,
please do not hesitate to call the undersigned at (408) 731-5000.

The Commissioner is hereby authorized to charge any additional fees which may
be required, or credit any overpayment to Deposit Account 01-0431.

Applicants respectfully request that a timely Notice of Allowance be issued in this
case.

Respectfully submitted,

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